

### III. REMARKS

#### A. Status of the Application

Claims 1 – 71 are pending. Claims 1, 25 and 33 are amended. Claims 5, 6, 9, 12, 16, 19, 24, 29 – 32 stand withdrawn. Support for the amendments to claims 1, 25 and 33 appears throughout the specification, for example, at Paragraphs [0021] – [0023] and [0026] – [0027], and Figs. 1 – 8. Reconsideration of this application in light of the above amendments and the following remarks is respectfully requested.

#### B. Election/Restriction

The restriction requirement setting forth the following species has been made final: Species 1, as illustrated in Figures 1 – 2; Species 2, as illustrated in Figures 3 – 4; Species 3, as illustrated in Figures 5 – 6; and Species 4, as illustrated in Figures 7 – 8.

In response to the final restriction requirement, Applicant elects Species 3.

#### C. Provisional Obviousness-Type Double Patenting Rejection

Claims 1 – 4, 7, 8, 10, 11, 13 – 15, 17, 18, 21 – 23, 25 – 28, 33 – 36, 39, 40, 42, 43, 45 – 48, 50 – 54, and 57 – 71 are subject to a provisional obviousness-type double patenting rejection over claims 1 – 58 of co-pending U.S. Patent Application No. 10/655,446.

Submitted herewith is a Terminal Disclaimer with respect to co-pending U.S. Patent Application No. 10/655,446. Accordingly, Applicant respectfully requests that the provisional rejection of claims 1 – 4, 7, 8, 10, 11, 13 – 15, 17, 18, 21 – 23, 25 – 28, 33 – 36, 39, 40, 42, 43, 45 – 48, 50 – 54, and 57 – 71 for obviousness-type double patenting be withdrawn.

#### D. Rejections over U.S. Patent No. 5,220,743 to McClellan

Claims 1 – 4, 7, 8, 10, 11, 13 – 15, 17, 18, 21 – 23, 25 – 28, 33 – 36, 40, 42, 43, 45 – 48, 50 – 54, and 57 – 71 stand rejected under 35 U.S.C. § 102(b), or in the alternative, under 35 U.S.C. § 103(a), over U.S. Patent No. 5,220,743 to McClellan ("McClellan"). Insofar as it may be applied against the present claims, this rejection is respectfully traversed.

As to the rejection under 35 U.S.C. § 102(b), MPEP § 2131 provides that "[t]o anticipate a claim, the reference must teach every element of the claim...." However, McClellan does not

meet the standard required by MPEP § 2131 because McClellan does not disclose or suggest each and every element of independent claims 1, 25 and 33, nor the claims dependent thereon.

Claim 1 is drawn to a fish hook comprising a hook shank, a bend in one end of the hook shank, a hook tip terminating the bend, a hook eye provided on an opposite end of the hook shank from the bend, and a weight. The weight has a lower weight taper tapered to the hook shank, and a top weight taper that terminates closer to the hook eye than to the hook tip. Claims 2 – 4, 7, 8, 10, 11, 13 – 15, 17, 18, 20 and 21 – 23 each depend directly or indirectly from claim 1, and therefore include each of the foregoing elements.

Claim 25 is drawn to a fish hook comprising a straight hook shank segment, a bend provided in one end of the straight hook shank segment, a reverse bend terminating the bend, a hook tip terminating the reverse bend, a hook eye provided on an opposite end of the straight hook shank segment from the bend, and a weight. The weight has a lower weight taper tapered to the hook shank and a top weight taper that terminates closer to the hook eye than to the hook tip. Claims 26 – 28 each depend directly from claim 25, and therefore include each of the foregoing elements.

Claim 33 is drawn to a lure comprising a lure body and a hook at least partially embedded in the lure body. The hook comprises a hook shank, a bend provided in one end of the hook shank, a hook tip terminating the bend, a hook eye provided on an opposite end of the hook shank from the bend, and a weight. The weight has a lower weight taper tapered to the hook shank and a top weight taper that terminates closer to the hook eye than to the hook tip. Claims 34 – 71 each depend directly from claim 33, and therefore include each of the foregoing elements.

Elements of each of the claims presently rejected under 35 U.S.C. § 102(b) over McClellan include a weight having a lower weight taper tapered to a hook shank and a top weight taper that terminates closer to a hook eye than to a hook tip.

In contrast to claims 1 – 4, 7, 8, 10, 11, 13 – 15, 17, 18, 21 – 23, 25 – 28, 33 – 36, 39, 40, 42, 43, 45 – 48, 50 – 54 and 57 – 71, McClellan discloses a back weighted fishhook 1 having a shank 2 with an eye 3 at its first end, a reverse bend 5 at its second end 6, and a sinker means 10 secured to the shank. (Col. 2, lines 47-61). The reverse bend terminates in a hook point 7. The shank 2 has center of balance 9, which is defined as “the location or point on the shank of the hook upon which the bare hook can be balanced”, such as on a knife edge. (Col. 2, lines 51-55).

The sinker means 10 has a first terminal end 13, which is distal to the second end 6 of the fishhook, and a second terminal end 14, which is proximal to the second end 6 of the fish hook.

It is a critical feature of the fishhook that the entirety of the sinker means be located between the center of balance 9 and the second end 6 of the fishhook. In particular, McClellan states that “[f]or this invention to achieve its objectives, [terminal] end 13 [of the sinker means] must be located between the center of balance 9 and the end 6 of the hook.” (Col. 2, line 67 – Col. 3, line 2). As between the terminal ends 13 and 14, terminal end 13 is the closer to the eye 3 of the fishhook. However, McClellan clearly states that the terminal end 13 of the sinker means 10 must be located behind the center of balance 9. Thus, both the terminal ends 13 and 14 of the fishhook described by McClellan are closer to the hook point 7 than they are to the eye 3. Accordingly, McClellan cannot disclose, suggest or motivate a fishhook or a lure comprising a weight having a top taper which terminates closer to the hook eye than to the hook tip.

Additional disclosure by McClellan that requires the entirety of the sinker means to be located behind the center of balance 9, and therefore have both terminal ends 13 and 14 located closer to the hook point 7 than to the eye 3, include the following:

- “point 7 of hook 1 must overlap sinker means 10” (Col. 3, lines 8-9);
- “sinker means 10 properly located behind center of balance 9” (Col. 3, lines 52-53); and
- “Sinker means 35 is located entirely on the rear portion 34 behind center of balance 9 with its end 36 being adjacent the center of balance, and no part of the sinker means extends past the center of balance toward front end 28” (Col. 4, lines 15-18).

Thus, McClellan clearly does not disclose, suggest or motivate a fishhook or a lure comprising a weight having a top taper that terminates closer to the hook eye than to the hook tip.

McClellan fails to meet the standard required by MPEP § 2131 to sustain the present rejection of the independent claims, namely, claims 1, 25 and 33, because McClellan does not disclose or suggest each and every element of these claims. Moreover, the rejection over McClellan of the dependent claims, namely, claims 2 – 4, 7, 8, 10, 11, 13 – 15, 17, 18, 20 – 23, 26 – 28 and 34 – 71, also fails to meet the standard required by MPEP § 2131 for at least the same reasons as apply to claims 1, 25 and 33. Accordingly, Applicant respectfully requests that the rejection of claims 1 – 4, 7, 8, 10, 11, 13 – 15, 17, 18, 21 – 23, 25 – 28, 33 – 36, 40, 42, 43, 45 – 48, 50 – 54, and 57 – 71 under 35 U.S.C. § 102(b) over McClellan be withdrawn.

To sustain the present rejection of claims 1 – 4, 7, 8, 10, 11, 13 – 15, 17, 18, 21 – 23, 25 – 28, 33 – 36, 40, 42, 43, 45 – 48, 50 – 54 and 57 – 71 under 35 U.S.C. § 103(a) over McClellan, a prima facie case of obviousness must be established. MPEP § 2142 provides that a prima facie case of obviousness requires three elements. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. In the present case, none of the elements set forth in MPEP § 2142 have been satisfied with respect to independent claims 1, 25 and 33, nor the claims dependent thereon.

As discussed above with respect to the rejection over McClellan based on 35 U.S.C. § 102(b), McClellan does not disclose, suggest or motivate all of the limitations of claims 1 – 4, 7, 8, 10, 11, 13 – 15, 17, 18, 21 – 23, 25 – 28, 33 – 36, 40, 42, 43, 45 – 48, 50 – 54 and 57 – 71. As at least one of the elements of a prima facie case of obviousness has not been met, a prima facie case of obviousness against claims 1 – 4, 7, 8, 10, 11, 13 – 15, 17, 18, 21 – 23, 25 – 28, 33 – 36, 40, 42, 43, 45 – 48, 50 – 54 and 57 – 71 over McClellan.

Moreover, Applicant notes that there is no suggestion or motivation, either in McClellan itself or in the knowledge generally available to one of ordinary skill in the art, to modify McClellan to arrive at the subject matter of claims 1 – 4, 7, 8, 10, 11, 13 – 15, 17, 18, 21 – 23, 25 – 28, 33 – 36, 40, 42, 43, 45 – 48, 50 – 54 and 57 – 71. McClellan expressly recites that locating the sinker entirely between the center of balance 9 and the second end 6 of the fishhook is a critical feature of the fishhook. (See Col. 2, line 67 – Col. 3, line 2 and Col. 4, lines 15 – 18). This critical feature necessarily requires that both the terminal ends 13 and 14 of the fishhook described by McClellan are closer to the hook point 7 than they are to the eye 3. Accordingly, there is no suggestion or motivation in McClellan to provide a fish hook or a lure that comprises a weight having a top taper which terminates closer to the hook eye than to the hook tip.

Further, one of ordinary skill in the art would not be motivated to modify the fish hook disclosed by McClellan to achieve the subject matter of claims 1 – 4, 7, 8, 10, 11, 13 – 15, 17, 18, 21 – 23, 25 – 28, 33 – 36, 40, 42, 43, 45 – 48, 50 – 54 and 57 – 71 because there could be no reasonable expectation of success. As discussed above, McClellan expressly recites that “[f]or


this invention to achieve its objectives, [terminal] end 13 [of the sinker means] must be located between the center of balance 9 and the end 6 of the hook.” Thus, one of ordinary skill would not be motivated to locate the sinker means in a manner other than that disclosed by McClellan, and would certainly not expect such a modification to be successful.

In view of the foregoing, Applicant submits that a prima facie case of obviousness over McClellan has not and cannot be established with respect to claims 1 – 4, 7, 8, 10, 11, 13 – 15, 17, 18, 21 – 23, 25 – 28, 33 – 36, 40, 42, 43, 45 – 48, 50 – 54 and 57 – 71. Accordingly, Applicant respectfully requests that the rejection of claims 1 – 4, 7, 8, 10, 11, 13 – 15, 17, 18, 21 – 23, 25 – 28, 33 – 36, 40, 42, 43, 45 – 48, 50 – 54 and 57 – 71 under 35 U.S.C. § 103(a) over McClellan be withdrawn.

#### IV. Conclusion

Claims 1 – 71 are now pending in the present application. In view of the foregoing amendments, disclaimer and remarks, allowance of all pending claims is respectfully requested. The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

  
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